

17. A method of treating a chronic disease of atherosclerosis in a mammal in need thereof, which disease is characterized by excessive, undesired or inappropriate angiogenesis with an effective amount of a compound which inhibits which inhibits the production, transcription, translation or activity of 14 kDa PLA₂ and wherein the compound was used before or invented after the priority date of March 26, 1996.

REMARKS

Claims 1 to 17 are in the application. Claims 14 to 17 have been added. Claims 5, 6, and 10 to 12 have been allowed. Claims 14 to 17 have been added to include an additional proviso. Claims 1 to 4, 7 to 9 and 13 stand rejected as described below. No new matter is believed added.

Rejection under 35 USC §112, first paragraph

Claims 1 to 4, 7 to 9 and 13 are rejected under 35 USC §112, first paragraph as containing subject matter not described in the specification. Applicants respectfully traverse this rejection.

Specifically, the Examiner argues that there is lack of antecedent basis for the phrase "and wherein the compounds were invented after the priority date of March 26, 1996". It is contended that this recitation of date restrictions in the claims has "no basis for such terminology in the specification and would not reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention".

Applicants assert that the March 26, 1996 date is supported by the as-filed specification in the section entitled, "Cross-Reference to Related Applications," at page 1. This date is the priority filing date supported by the application, and is used because it is the date by which references will constitute prior art to this application.

Moreover, the Applicants are permitted to narrow their claim scope by inserting these date restrictions, such that they claim a sub-set of what was disclosed in the as-filed application. As the C.C.P.A. held in *In re Johnson*, 191 U.S.P.Q. 187, 195-96 (1977), it is perfectly legitimate for an applicant to claim less than his full scope of disclosure, since it is for an inventor to decide what bounds of protection he will seek. Likewise, the C.C.P.A. indicated, in *In re Wertheim*, 191 U.S.P.Q. 90, 97 (1976): "That what applicants claim as patentable to them is *less* than what they describe as their invention is not conclusive if their specification also reasonably describes that which they do claim."

Because the instant specification describes what PLA₂ compounds are, how to screen for them, and how they can be used as therapeutics, the Applicants contend that the specification does provide a reasonable written description of what they are now


claiming. Therefore, under the holdings of both *In re Johnson* and *In re Wertheim*, the Applicants submit that the recitation of the date restriction in the pending claims does have sufficient basis in the specification to and the skilled artisan would readily understand if they were in possession of the claimed invention.

Accordingly, the Applicants respectfully request reconsideration and withdrawal of the rejections of Claims 1 to 4, 7 to 9 and 13 under 35 U.S.C. § 112, first paragraph.

CONCLUSION

Should the Examiner have any questions or wish to discuss any aspect of this case, the Examiner is encouraged to call the undersigned at the number below. If any additional fees or charges are required by this paper the Commissioner is hereby authorized to charge Deposit account 19-2570 accordingly.

Respectfully submitted,


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